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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 10/734,442 | 12/12/2003 | Helmut Steinhilber | 074623.0111 | 9668 |
| 7590 | 12/22/2005 | | | |
| Andreas Grubert Baker Botts L.L.P. One Shell Plaza 910 Louisiana Houston, TX 77002-4995 | | | EXAMINER JOERGER, KAITLIN S | |
| | | | ART UNIT 3653 | PAPER NUMBER |
| DATE MAILED: 12/22/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/734,442 | STEINHILBER ET AL. | |
| | Examiner | Art Unit | |
| | Kaitlin S. Joerger | 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5, 6-10 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the flat plane" and "the direction" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the sheets" in line 1, "the feeding direction" in line 4, and "the flat plane" in line 7 to 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 claims an endless belt with a "lump". It is unclear what feature of the invention the word "lump" is referring to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 04333442 A.

Art Unit: 3653

The JP '44s patent teaches a device for selecting sheets from a pile, comprising a rolling action device, 19, a stop 9 mounted before the front edge of the pile, wherein the stop can be moved upwards at an impingement angle of at least 90 degrees in relation to the flat plane and the feed direction, see figure 1 and 2. The pile stop moves in the plane of its surface and is built of at least one belt, 17, which runs upward under the impingement angle, and whose lump is turned towards the pile, see figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04333442

A.

Although the JP '442 patent does not specifically teach a method for selecting sheet forms a pile, it would have been obvious to one of ordinary skill in the art to perform the method steps of claims 1-3 using the apparatus taught by the JP '442 reference, and described fully above, in its usual and expected manner.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04333442 A in view of 4,579,329.

Art Unit: 3653

The JP'442 patent does not teach a selection method wherein a dividing element is moved between the lifted front edge and the next sheet in the pile, but the '329 patent does. It would have been obvious to one of ordinary skill in the art to combine the dividing element of the '329 patent with the apparatus of the '442 patent if one desired to be able to surely separate the tope sheet from the pile and prevent two or more sheets from being removed from the pile at one time.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04333442 A in view of 4,579,329.

The JP'442 patent does not teach a dividing element that can be moved between the lifted front edge and the next sheet in the pile, but the '329 patent does. The '329 patent teaches a dividing element, 20, mounted before the front edge of the pile that can be moved between the uppermost sheet and the following sheet in the pile, the dividing element intervenes by means of a finger and includes a press-on roller, see figure 8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the dividing element of the '329 patent with the apparatus of the '442 patent if one desired to be able to surely separate the tope sheet from the pile and prevent two or more sheets from being removed from the pile at one time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

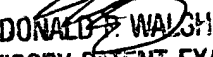
Art Unit: 3653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 571-272-6944. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksj


20 December 2005


DONALD F. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600